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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,177	04/06/2001	Alejandro H. Abdelnur	80168-0121	4373
32658	7590	07/27/2006	EXAMINER	
HOGAN & HARTSON LLP ONE TABOR CENTER, SUITE 1500 1200 SEVENTEEN ST. DENVER, CO 80202			KESACK, DANIEL	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/827,177	Applicant(s) ABDELNUR ET AL.	
	Examiner Dan Kesack	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,8-11,13 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,8-11,13 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment filed May 9, 2006 has been entered and fully considered. Original claims 8, 17, and amended claims 1, 3, 5, 9-11, 13, 16, and 18 are currently pending. The rejections are as stated below.

Specification

2. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and use the invention, i.e., failing to provide an enabling disclosure.

The test to be applied under the written description portion of 35 U.S.C. § 112, first paragraph, is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of later claimed subject matter. Vas-Cat, Inc. v. Mahurkar, 935 F. 2d 1555, 1565, 19 USPQ2d 111, 1118 (Fed. Cir. 1991), reh'rg denied (Fed. Cir. July 8, 1991) and reh'rg, en banc, denied (Fed. Cir. July 29, 1991).

The applicants have failed to provide an enabling disclosure in the detailed description of the embodiment. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to support the subject matter set forth in these claims.

While Application teaches the current invention calculates a “distance” between the polarity of normalized dimensions of the active order and the set of normalized dimensions for the passive orders (page 11 lined 11-15), this disclosure is not enabling for one to identify what the “polarity” of a normalized dimension is, or how it is used to calculate a “distance” between the orders.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 10 is rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 3, 8, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Luke et al., U.S. Patent No. 6,131,087.

Claim 3, Luke teaches receiving an active order, including a name value pair and characteristics (column 6 lines 45-60), determining the existence of a matching order among a plurality of stored passive orders which include an identical name value pair to that of the active order (column 7 lines 14-16), and includes normalized dimensions based on characteristics that match normalized dimensions corresponding to the received characteristics (column 5 line 60 – column 6 line 11). Luke further teaches matching offer and solicitation data based on submitted dimensions, and using submitted parameters to automatically evaluate the final offer and reach a decision, which inherently could be a rejection, even though the dimensions match. Examiner interprets this feature to encompass the claimed “applying a rule based filter to determine whether the passive order matches the active order, and rejecting matches which do not pass this criteria” (column 9 lines 13-26, column 9 line 57 – column 10 line 14).

Claim 8, Luke teaches determining the existence of a matching order among a plurality of stored orders (abstract, and figure 2 step 200).

Claim 13, Luke teaches the offer data including data identifying the homogenous good or service and data relating to the value of the homogenous good or service (column 6 lines 36-44).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1, 5, 8-11, 16-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Luke et al., U.S. Patent No. 6,131,087, in view of Macready, U.S. Patent Application Publication No. 2002/0016759.

Claim 1, Luke discloses a method for automatically identifying, matching, and near-matching buyers and sellers in electronic market transactions. Luke teaches solicitations for goods and services being received, said solicitations containing dimensions, including a product identifier, price, payment date, delivery destination (column 5 lines 62-67), said dimensions expressed in numeric terms on a linear scale by converting the dimensions from every solicitation to a standard format (column 6 lines 1-11), determining the existence of a matching order among a plurality of stored orders (abstract, and figure 2 step 200), and matching offer and solicitation data from market participants and notifying originators of the matching data of the results of any such matching operations (column 6 lines 16-19).

Luke fails to teach the dimensions being normalized by converting to a value between zero and one.

Macready teaches a system and method for identifying trades between parties by variables which define characteristics of offers, an normalizing said variables using a normalizing function, resulting in offer criteria within the range of [0, 1] (paragraph 60). This normalized criteria is then used to identify trades between parties. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the normalizing step of Luke to include converting all characteristics to a value between zero and one, because Macready teaches the feature requires the average distance of any negotiation variable from its ideal value is the same for all dimensions, and further because, "it is important to normalize the contributions of each variable so

that the buyer can weight the importance of various contributions to utility (paragraph 24).

Claim 5, Luke teaches the characteristics including one or more of price, quality, quantity, and time (column 6 lines 36-44).

Claims 9, 10, Luke teaches comparing the normalized dimensions of standing and current solicitation data in order to determine if an intersection occurs, intersections occurring as perfect matches, or near-matches, wherein the "polarity" is interpreted to mean the upper and lower limits of the offer, and the distance calculation is embodied by the tests conducted by formulas (column 7-8, 205.1-207.4 and figures 2C, 2D).

Claim 11, Luke teaches searching for a match using the "preferred" data point of a dimension of a solicitation, and increasing the range of the solicited dimension by expanding the search to include lower and upper limits; if no match is found (figure 2A).

Claim 16, Luke teaches notifying an entity associated with an order if a match is made (column 6 lines 16-19).

10. Claims 17 and 18 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Luke as applied to claim 1 above, and further in view of Walker et al., U.S. Patent No. 6,418,415, as cited in the prior action.

Response to Arguments

11. Applicant's arguments with respect to claims 1 and 3 have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's arguments filed May 9, 2006 with respect to claims 9, 10, 16 have been fully considered but they are not persuasive.

13. In regards to Claim 9, Applicant believes that the language makes it clear that the determining of a match step involves comparing the axes for a set of normalized dimensions to find an intersection, and that the intersection of normalized dimension axes is required by claim 9. Examiner respectfully disagrees. Claim 9 recites the comparing of *normalized dimensions* to determine whether an intersection occurs on the axes (Emphasis added). Figure 1b of Luke clearly shows comparing the dimensions for each axis, and when combined with the normalization taught by Macready, as cited above, this feature meets the claim language.

14. In regards to Applicant's disagreement of the rejection of claim 16, which depends from claim 10, Examiner's rejection of claim 10 includes the feature of the distance calculation. Examiner respectfully points out that claim 16 does not claim the step of distance calculation, but rather refers to the distance calculation of claim 10.

Therefore, Examiner is of the opinion that the rejection is proper for the reasons cited in the previous office action, repeated above.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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